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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/411,075 10/04/99 SRIVASTAVA

P 8449-054-999

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HM12/0605

EXAMINER

DAVIS, K

ART UNIT

PAPER NUMBER

1636

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/411,075

Applicant(s)

SRIVASTAVA, PRAMOD K.

Examiner

Katharine F. Davis

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1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 51-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This Office Action is in response to the application filed on October 4, 1999 and to the Preliminary Amendment filed March 19, 2001. Claims 1-50 have been canceled. New claims 53-73 have been added. Claims 51-73 are pending in the instant application.

#### *Election/Restrictions*

Applicant's election of Group V in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)). New claims 53-73 are deemed to belong in Group V. Thus, claims 51-73 have been examined.

#### *Specification*

The abstract of the disclosure is objected to because it has two paragraphs. Correction to one paragraph is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: the Table of Contents (pages i-iii) references specific page numbers of the instant specification. It is required that the page numbers be deleted from the Table of Contents.

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In the Brief Description of the Drawings each panel or drawing containing multiple panels must be referred to as a separate figure. The first line of each description must refer to each separate figure (e.g., Figures 1A-1C). Correction is required for Figures 1-3.

#### *Claim Objections*

Claims 72 and 73 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim.

See MPEP § 608.01(n).

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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This rejection is based on the Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, first paragraph "Written Description" Requirement published in the Federal Register (Volume 64, Number 244, Pages 71427-71440). Claims 51-73 are drawn to a method for screening a molecule for the ability to modulate heat shock protein receptor activity. These are genus claims encompassing any heat shock protein receptor from any organism that can display any type of receptor activity. The instant specification discloses three heat shock protein receptor(s): a receptor that binds hsp70, a receptor that binds hsp90, and a receptor that binds gp96. However, it is unclear (based on the instant specification) if one heat shock protein receptor binds the three disclosed heat shock proteins (hsp70, hsp90 and gp96) or if there are three distinct heat shock protein receptors. Furthermore, it is unclear from what species the claimed heat shock protein receptors have been derived. The instant specification teaches how to identify the murine gp96 heat shock receptor in the example (pages 109-116). However, the instant specification does not describe or teach how to identify other receptors for other heat shock proteins in any other organisms. The disclosure of the three heat shock protein receptors is not deemed to be descriptive of the complete structure of a representative number of species encompassed by the claims as one of skill in the art cannot envision the complete structure of any other heat shock protein receptor based on the disclosed heat shock protein receptors. Additionally, there is no description of a representative number of species by partial structure and a function which correlates with a structure as there is no disclosure of the properties and/or characteristics that constitute a heat shock protein receptor. Furthermore, there is no disclosure of the activities that specifically describe receptor activity. Therefore, the specification does not describe the claimed heat shock protein receptors in such full, clear,

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concise and exact terms so as to indicate that applicants had possession of these receptors at the time of filing of the present application. Thus, the written description requirement has not been satisfied.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51 and 53-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 51 recites the term "receptor activity" in line 2. It is not clear what activities specifically constitute heat shock protein receptor activity, therefore the metes and bounds are undetermined rendering the claims indefinite.

Claim 55 recites the term "heat shock protein receptor positive cells." There is insufficient antecedent basis for this term in the claim.

### ***Conclusion***


Claims 51-73 are rejected. Claims 51-73 are free of the prior art. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195. The examiner can normally be

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reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Schwartzman can be reached on (703) 308-7307. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry concerning the formalities of this application should be directed to Patent Analyst Dianiece Jacobs whose telephone number is (703) 305-3388. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Katharine F. Davis  
June 4, 2001

  
ROBERT A. SCHWARTZMAN  
PRIMARY EXAMINER